

No. 20944

In the
United States Court of Appeals
For the Ninth Circuit

HARRY P. LOCKLIN and ELMER J. BRANT,
general partners doing business under the
firm name of Radiant Color Company,

Plaintiffs-Appellants,

vs.

SWITZER BROTHERS, INC.,

Defendant-Appellee.

Appellants' Reply Brief

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This Court, in reviewing the briefs thus far filed, may encounter some doubts because Radiant in its Opening Brief has treated the evidence and the law on each of the two questions which it has presented for review as being distinct from each other and as resting on its own merits whereas Switzer has intermingled its response. Radiant, in its discussion of the merits of the contempt appeal, accepted fully and without qualification the doctrine of the law of the case and argued on its own merits the proposition that the accused pigments did not infringe the Kazenas claims. After having so argued, Radiant then directly, and not obliquely as suggested by Switzer (Sw. Br. 33), urged that this Court should reconsider its earlier holding that the Kazenas patent complied with U. S. Code, Title 35, Section 112. Switzer has so intermingled references to Radiant's contentions on both issues,

as well as its limited responses to Radiant's argument, that Radiant now emphasizes that each of the two questions is presented on its own independent merits. There was, and is, no intent or desire on the part of Radiant to intermingle the several contentions made with respect to each of these two fully independent questions.

With this foreword, Radiant discusses the two questions independently and now shows that—

**Switzer's contentions that Radiant does infringe the
Kazenas claims should be rejected**

On the merits of the only issue which this Court directed the District Court to determine, Radiant's reply, in general, to the contentions advanced by Switzer could be nothing more than a repetitious restatement or re-emphasis of that which Radiant has already set forth in its Opening Brief. Therefore, rather than to belabor a 'tis 'tisn't argument in this brief, Radiant responds directly only to certain highlights of Switzer's brief. Before so doing, Radiant correlates those portions of the presently filed briefs and submits its reply in general as follows:

Switzer's general point that the evidence and Radiant's admissions establish infringement (Sw. Br. 10-12) is submitted upon Radiant's preliminary discussion of evidence on the first question (R. Br. 8-12), Radiant's point that the District Court erred in its choice of test resins (R. Br. 13-20) and Radiant's summation (R. Br. 32).

Switzer's contentions regarding the lapse of time for evaluating insolubility (Sw. Br. 12-17) are submitted on Radiant's argument that the District Court erred in lapse of time for evaluating insolubility (R. Br. 23-32).

Switzer's contentions regarding the benzene issue (Sw. Br. 17-21) are submitted on Radiant's argument that the District Court erred in defining aromatic hydrocarbon solvents (R. Br. 20-23).

Switzer's contentions on the quantitative test results (Sw. Br. 21-25) are submitted on Radiant's argument that the District Court erred in considering quantitative tests of solubility (R. Br. 33-36).

Switzer's contentions on the urea issue (Sw. Br. 25-30) are submitted on Radiant's argument that the District Court also erred in its evaluation of the urea containing test resins (R. Br. 36-39).

Switzer's contention that Rule 52(a) controls the issues on appeal (Sw. Br. 30-32) is submitted on Radiant's argument that Rule 52(a) does not control the issues on this appeal (R. Br. 12-13).

Before discussing specific issues, Radiant apologizes both to this Court and to Switzer for the trouble and confusion which Radiant may have occasioned in connection with specification 1 (Sw. Br. 5-7). As written (R. Br. 5), specification 1 is plainly wrong. That specification should have read that the District Court erred:

1. When it failed to find that tests made with Radiant's inter partes test resin produced on September 2, 1965 proved that a resin made with the melamine, sulfonamide, and aldehyde raw materials as used in the manufacture of the accused pigment is *not* one which will remain free flowing in either of the aromatic hydrocarbon solvents benzene or toluene;

Radiant asks leave to correct that specification. No prejudice can arise out of recasting specification 1 for the simple reason that the argument on specifications 1 through 8 shows that such was the true intent of the specification (R. Br. 13-20). The accused pigment *per se* was admitted to be free flowing in both solvents on the initial contempt appeal and on this appeal as well (R. Br. 38-39).

Another preliminary matter concerns Switzer's contention that a certain statement of Radiant's expert, Mr. Bennahmias, "is binding upon Radiant as an admission that a 7-4-1 MSF resin (without urea) can be made that is substantially insoluble in aromatic hydrocarbon solvents" (Sw. Br. 26). That statement relied upon by Switzer as an admission was *not*, in fact, made by Mr. Bennahmias, and Radiant asks that the inaccuracy be corrected by a Motion to this Court, supported by affidavits of the court reporter, the witness and one of plaintiffs-appellants' attorneys.

The reported statement at page 446, lines 7-10 of the transcript, is almost directly opposite to the actual testimony of the witness. The supporting affidavit of the court reporter clearly shows that the transcript on file is in error and that the transcript, page 446, lines 7-10, should read:

"THE WITNESS: According to my experience, I am positive that you could make a resin of the 7-4-1 proportions and obtain substantially solubility in aromatic hydrocarbon solvents."

While the foregoing statement is garbled or ungrammatical, its import is clearly to the effect that according to the witness's experience resins made in the 7-4-1 proportions would be substantially *soluble* rather than substantially insoluble in aromatic hydrocarbon solvents. Mr. Bennahmias throughout his testimony consistently maintained that resins made in the 7-4-1 proportions could *not* be made substantially insoluble in aromatic hydrocarbon solvents (RT. 409-410; 418; 420-421; 467-468). This point was made in so many instances, it is peculiar that Switzer could be confused or misled by the erroneous transcript. In any event, Radiant should not be bound by an erroneous transcript of an "admission" which was never made.

On the merits of the infringement issue, Switzer's principal and all pervading point is that the "simple, clear test" to which this Court referred in its initial holding is a quick qualitative test,* using toluene, which required only 24 hours, or, at most, less than a week to carry out. This test forms the keystone for Switzer's entire argument (Sw. Br. 2-4, 6-7, 10, 29, amongst others). Switzer even goes so far as to say that this Court had reference to that test in its first opinion (Sw. Br. 2, 14, 31) and that it became "the law of the case" (Sw. Br. 3, 7, 19, 29). Switzer urges that such test is "the only correct basis" (Sw. Br. 10).

*Reference in this brief to a "quick qualitative test" refers to the peculiar quick test adopted and used by Switzer in connection with the contempt proceeding. It is not to be confused with Dr. Hatcher's test which is quick to perform but required subsequent observation to demonstrate at least a four-months free flowing capability.

Here then is a clearly defined issue which this Court may truly find decisive of the merits on the appeal. Indeed, if Switzer correctly recites the "simple, clear test" which this Court adopted in the first instance, the judgment below *must be* sustained on the merits. Radiant cannot soundly urge, and it does not urge, that any of the test resins failed to meet that test.

Radiant's burden on this crucial issue, therefore, is to demonstrate that the "the only correct basis" which Switzer now urges is not a test upon which this Court relied in the first instance and that such a test could not have been deemed controlling. In making this demonstration, Radiant pursues every area of true substance which could conceivably relate to such a test and submits that such demonstration proves the error of Switzer's contention.

1. Notwithstanding Switzer's repetitious assertions that this Court did rely upon such a test, it should be conclusive on this issue that this Court in its earlier opinion did not even use any of the words "quick," "qualitative," "toluene," "24 hours," or "one week" at any place in its entire decision. Radiant assumes that, if this Court had reference to a test based upon such considerations, it would have said so. At any rate, Radiant submits, "Certainly, omissions do not constitute a part of a decision and become the law of the case . . ." [*Hartford Life Ins. Co. v. Blincoe* (1921), 255 U.S. 129, at page 136].

2. This Court's reference to "testimony" upon which it referred to find the presence of "a simple, clear test" does not state that the test is one of the peculiar character proposed by Switzer. This Court, as did Judge Goodman, relied upon the testimony of Dr. Hatcher on all critical issues. His testimony with regard to the solubility test which supported this Court's determination that there was "a simple, clear test" is simply stated in one question and answer (OR 397):

"Q. How difficult is the solubility test for a resin?

"A. It is not difficult. It is readily observable."

He did not qualify the test. He demonstrated that the Kazenas resin was insoluble in toluene by showing that it remained free flowing after a lapse of more than four months (OR

400-401, 412). Such a test is not difficult and it is readily observable. It fulfills this Court's reference to "a simple clear test." Dr. Hatcher never did testify directly or inferentially that the quick qualitative test now proposed by Switzer was sufficient to evaluate substantial insolubility of any resin. Radiant challenges Switzer on the oral argument to quote any testimony of Dr. Hatcher used in the original trial for thus evaluating substantial insolubility.

3. Switzer should not now be permitted to argue that it adopted and used in the original trial any test which required only 24 hours or, at most, less than a week to carry out. If that had been its position at the original trial, there would have been no point in Switzer arguing, as it did in its Brief for Defendant-Appellee in No. 16,780.

In that brief, Switzer, in the introduction to its argument that the original findings of fact were based on the record, stated, p. 5:

"... We propose to show, in detail and by reference to the transcript of the record, the evidentiary bases for each of the main findings of fact set forth in the Memorandum of Court (recited substantially verbatim in the headings below):"

Under its heading, page 8, "'The Kazenas resin 'is insoluble in common paint solvents such as aliphatic and aromatic hydrocarbons, and hence, can be suspended in such vehicles without coalescence or agglomeration' (R. 125)", Switzer said, pages 9-10:

"... Dr. Hatcher explained to the Trial Court that when he dispersed the Kazenas Example 5 resin in toluene: 'It did not agglomerate. It remained free-flowing' (R. 400).

"This initial toluene insolubility test for the Kazenas resin of Dx. N had been carried out some four months before the trial (R. 401), yet Dr. Hatcher was able to demonstrate these test results to the Court at the time of trial since the resin was still free-flowing in Dx. N. (R. 401). . . ."

Later, under its argument, page 22, that "'The only prior art reference specifically describing the modification of a sulfonamide-aldehyde resin with melamine is the Japanese patent No. 181,405 for a method of producing a highly waterproof paratoluol-sulfamide resin of a high melting point . . . but it differs in at least one vital respect in that it is soluble in aromatic hydrocarbons, while

the Kazenas resin is substantially insoluble' (R. 131, 132)", Switzer stated, page 25:

" . . . Dr. Hatcher explained to the Trial Court that when the Kazenas Example 5 resin was tested for insolubility by dispersing it in toluene: 'It did not agglomerate. It remained free-flowing' (R. 400). Such testing took place some four months before the trial (R. 401). Since then, Dr. Hatcher had retained Dx. N in his possession and was able to demonstrate to the Trial Court that the resin was still free-flowing at the time of trial (R. 401)"

Still later, in answer to Radian's contentions on the new trial issues, Switzer said, page 70:

"Here the Trial Court had the opportunity at the trial of seeing Exhibit N in the condition of a free-flowing powder in toluene and of hearing Dr. Hatcher's testimony with regard to that exhibit. It believed Dr. Hatcher."

In the second and third of the previous quotations, Radian has intentionally omitted all accompanying references in which Switzer tried to tie the four month test period into the pretrial affidavit of Dr. Hatcher. This, for the simple reason that this pretrial affidavit was not in evidence before Judge Goodman and Dr. Hatcher did not even purport to testify in support of that affidavit. At the trial, Dr. Hatcher's testimony was presented on its own merits. Radian submits that Switzer's recognition that there was some permanence to be required with regard to free flowing characteristics should not be relegated to mere idle chit chat.

To the contrary, Radian submits that the testimony and contentions to which reference has thus been made are the true support for this Court's conclusion that "The Kazenas patent is for a resin . . . which is thermoplastic but still is capable of being finely ground and which remains insoluble without agglomeration in aromatic hydrocarbon solvents." Radian submits that Switzer's prior argument and the close tie-in between that argument and the conclusions of this Court make it most presumptive to urge that "remains" contemplates a mere ephemeral period of "only 24 hours, or, at most, less than a week."

4. The opinion of the District Court made upon the original trial does not support Switzer's presently adopted quick qualitative test as Switzer so confidently asserts (Sw. Br. 14). That opinion (OR 124-140) is entirely silent as to the test to be applied. The ultimate conclusion that "the functional expressions define the limits of the invention more precisely than would have been practically possible by wholly mathematical expressions." (OR 137) does not suggest any quick qualitative test which may be used to define the critical boundary line between the Japanese resin and the Kazenas resin. Nor does the earlier vital finding that the Japanese resin "is soluble in aromatic hydrocarbons, while the Kazenas resin is substantially insoluble" (OR 132) fill that void. That finding was based upon Dr. Hatcher's experiments (299 F.2d at page 163), and he demonstrated his test results after more than four months' time had elapsed. At no point in his entire opinion did Judge Goodman give the slightest inkling that he accepted, or even knew, that "the only correct basis" was the peculiar 24 hour, or less than a week, test which Switzer now proposes.

5. Switzer's contention that the quick qualitative test must be accepted because Radiant's expert Mr. Paulsen testified at the original trial on the basis of tests which he conducted over a period of one week should also be rejected. In the first place, his tests did not touch the issue here. Several of his test resins actually agglomerated in less than a week. Clearly, if they had agglomerated in less than a week, there was no need to watch them over a period of four months to see whether or not they would become agglomerated. But more importantly than that, it is incredulous to believe that either this Court or the District Court below did in fact rely upon any tests of Mr. Paulsen as being reliable upon this critical issue when it rejected the conclusions reached by Mr. Paulsen on those same tests. Radiant simply does not believe that this Court relied upon any of the testimony of Mr. Paulsen in sustaining the initial judgment. Radiant urges that Switzer is quite presumptive in suggesting that Mr. Paulsen was a good expert when it suits Switzer's purposes and that he

was a bad expert when it suits Radiant's purposes. He was either good or bad, but cannot logically be held to be both with regard to the same general subject matter.

In any event, Radiant submits that it did not adopt any short qualitative test as being "the only correct basis" to determine the presence or absence of substantial insolubility. Those portions of Appellants' Opening Brief on the first appeal set forth in Appendix A attached to this brief show otherwise.

6. Nothing in the patent claims or in the patent specification itself even suggests that the quick qualitative test is one to be used in assessing substantial insolubility. Certainly the words of the claim that the resin is "substantially insoluble in aromatic hydrocarbon solvents" and the words of the specification that a pigment made of the resin is "practically insoluble in aromatic hydrocarbon solvents" do not describe such a test. Certainly the words that the new resin is insoluble in many common vehicles and can therefore be suspended in such vehicles without coalescence or agglomeration do not describe such a test. Certainly the words that the pigments may be used in vehicles which are non-solvent for the pigments to form various types of inks and the like do not describe such a test.

Dr. Hatcher, after examining the Kazenas specifications for teachings regarding insolubility, did not refer to any such test (OR 423-424, 468-469). However, since his examination was not directed to the precise nature of testing, Dr. Hatcher's attention may not have been directed to that specific issue. Radiant, therefore, challenges Switzer to quote at the oral argument any words in the specification which define or clarify the quick qualitative test which Switzer now advances.

Switzer's efforts now to rely upon extraneous considerations to read into the words "substantially insoluble" a test which is not defined in the patent should be rejected out of hand upon the authority of *Duff-Norton Company v. Ratcliff* (9 Cir. 1966), 362 F.2d 551. There the patentee tried by argument to read substance into the words "closely adjacent" as used in the claims. This Court, speaking through Judge Merrill, stated, page 553,

"'Closely adjacent,' however, is nowhere defined in the patent. The phrase appears only in the claims. Absent definition or clarification, such relative and general language cannot be held to impart patentable distinction or novelty over prior art."

It follows, by a parity of reasoning, that Switzer cannot rely upon a test which is not defined in the patent nor clarified therein.

7. Switzer's argument that Radian should not now be permitted to object to the quick qualitative test because it did not put in contrary evidence at the original trial (Sw. Br. 3) should be rejected. That issue was not even before the Court at the original trial. No quick qualitative test was used to prove infringement because the original accused pigments were substantially insoluble in aromatic hydrocarbon solvents, either benzene or toluene, and remained insoluble in such solvents. Thus, the original record would not even have warranted the introduction of evidence on the adequacy of testing. In this connection, Dr. Hatcher testified unequivocally that the Kazenas resin was substantially insoluble in aromatic hydrocarbon solvents and demonstrated that it had remained free flowing in toluene for at least four months. The sufficiency of a quick qualitative test was thus not before either this Court or the District Court on the original appeal and trial. Even the substitute pigment charged as being an infringement on these contempt proceedings has remained free flowing in both benzene and toluene for a period of more than two years.

8. The quick qualitative test can at best make the difference between a Kazenas resin and a Japanese resin a mere difference in degree and not a difference in kind. Switzer, at the original trial and on the original appeal, persuaded both this Court and the District Court that there was a difference in kind between the two resins rather than a difference in degree. There has been no suggestion that a resin which will agglomerate in aromatic hydrocarbon solvents immediately after the passage of one day or at most one week has any practical utility over and above the practical utility of a Japanese resin. Switzer virtually concedes that its present argument requires the patent in suit to support "a distinction in degree between the insolubility of the Kazenas resin"

in the respects noted in the patent specification. Thus, Switzer argues in a full circle. It now in substance makes the same argument to sustain infringement as that which Radiant unsuccessfully made to urge invalidity on the first appeal.

9. Switzer's own expert on the contempt appeal admitted that the quick qualitative test was meaningless. Mr. Gray, on cross-examination, was asked the following questions on this subject matter (RT 164):

"Q. Is a paint in which the pigment is insoluble without agglomeration in aromatic hydrocarbon solvents in which the stuff will be agglomerated within a day, is that a salable paint?"

"A. No.

"Q. Is it salable if it will remain suspended for one week?"

"A. Probably not. It depends on your use and your customer."

Thus, at best, the quick qualitative test which Switzer now suggests has nothing to do with the issue as to whether the pigment is "practically insoluble", the words used in the specification as the predicate for the words "substantially insoluble" of the claims. Switzer's test makes the patent a mere hunting license, wholly unrelated to the world of commerce. But, in *Brenner v. Manson* (1966), 383 U.S. 519, an opinion by Mr. Justice Fortas pointed out, page 536, "But a patent is not a hunting license. It is not a reward for the search, but compensation for its successful conclusion. '[A] patent system must be related to the world of commerce rather than to the realm of philosophy. . . .'"

That the quick qualitative test is the only test is pure philosophy, nay even fantasy. Switzer has never shown such a test has any utility whatsoever, either on this appeal or on the prior appeal. As Judge Sweigert found, "the testing of a resin in any pure aromatic hydrocarbon solvent is merely an indication of the substantial insolubility of the resin in a paint vehicle." (CT 114). Yet it is now binding upon all courts that "Congress intended that no patent be granted on a chemical compound whose sole 'utility'

consists of its potential role as an object of use-testing" [*Brenner v. Manson* (1966), 383 U.S. 519, at page 535]. Switzer suggests no purpose other than the object of use testing for its quick qualitative test.

Switzer's reliance upon *Research Products Co. v. Tretolite Co.* (9 Cir. 1939), 106 F.2d 530 (cited Sw. Br. 20) illustrates the deficiencies in Switzer's present contention that the quick qualitative test is "the only correct basis" (Sw. Br. 10). In *Research Products*, the patent specification clearly spelled out the nature of the modified fatty acids and sulfo-fatty acids involved in the action (106 F.2d at p. 533). In the case at bar, the quick qualitative test is not spelled out any place as being "the only correct basis" (or for that matter any basis at all) for deciding the critical issue of infringement involved on this appeal.

That *Research Products* is not entitled to embrace a situation where the specification is silent as shown by its distinction in *Van Brode Milling Co. v. Cox Air Gauge System, Inc.* (9 Cir. 1960), 279 F.2d 313, at page 318.

In summation, Radiant urges that the quick qualitative test now adopted by Switzer as "the only correct basis" (Sw. Br. 10) should be rejected. If this is the proper test, Switzer has only demonstrated that the patent and the prior judgment as well are invalid. But validity must be assumed on the merits of the contempt charge (Sw. Br. 19, adopting R. Br. 23). If this is not the proper test, then Switzer has shown no other basis for carrying its burden of proof on the contempt issues. In either event, the judgment should be reversed on the merits.

Having thus far accepted full validity of the patent and earlier decree, and having now argued that the contempt judgment should be reversed on its own merits, we turn to the second question and urge that—

This Court should overrule its prior judgment and hold the Kazenas patent invalid under U. S. Code, Title 35, Section 112

Radiant submits that Switzer has evaded the crux of Radiant's argument on this important issue. Switzer, in a single paragraph

(Sw. Br. 38), casts aside Radiant's crucial point that there has been a significant change in facts and circumstances on the ground that it is based upon "spurious premise" which has been "fully refuted" in Switzer's response to Question 1. Radiant submits that Switzer has made no response at all to Radiant's propositions that *Switzer has now proved* that:—there is no critical point which remains the same for each melamine compound (R. Br. 50-62); the general description does not define the invention (R. Br. 62-66); there is no clear test to determine substantial insolubility (R. Br. 66-71); and aromatic solvents are indefinite (R. Br. 71-75). Switzer's argument on the merits of the appeal is not truly directed to the merits of any of those points. All quotations by Radiant to testimony are taken directly from the mouths of Switzer's own experts. The facts, Radiant submits, thus stand conceded.

To these conceded facts, there should now be added the new ambiguity which Switzer has created by its present contention that the quick qualitative test in toluene is the "only correct basis" to determine whether the amount of melamine is sufficient to render the resin substantially insoluble in aromatic hydrocarbon solvents. Certainly when one can argue so forcefully that the claims are to be construed by reference to a quick qualitative test after having relied upon a four month history of free flowing capacity to maintain novelty, he should not be permitted to maintain that his claim to invention is particularly pointed out and distinctly claimed as required by the statute.

Indeed, the mere fact that Switzer must now rely upon credibility of witnesses to help delineate the claims (Sw. Br. 13, 30-31) proves that the claims themselves are not definite or precise. They now mean whatever any witness who is deemed credible by the Court says they mean. Congress could not have intended so subjective and flexible a standard in drafting the statute. The admittedly relative, comparative language used in the Kazenas claims (Dr. von Fischer, RT 228-230, 248, 250, 253) and the position taken by Switzer on the contempt proceedings now brought under

the claims of that patent illustrate the hazards of carving any exception in this case to the sweeping demand which Congress made in U. S. Code, Title 35, Section 112 [Cf. *Halliburton Co. v. Walker* (1946), 329 U.S. 1, at p. 11].

Radiant now replies to issues upon which Switzer has made a specific response.

Switzer's first point is that Question 2 is not properly before this Court because that question was not remanded to the District Court, was not presented to that Court and was not passed upon by that Court (Sw. Br. 4, 33). Radiant submits that the question is one under the sole control of this Court, that Radiant had no right to present that question to the District Court and that the District Court had no right to deviate from the law of the case without express permission of this Court [*Atlas Scraper and Engineering Co. v. Pursche* (9 Cir. 1966), 357 F.2d 296]. This Court, in the exercise of its sound discretion, denied to Radiant the privilege to present an appropriate motion to the District Court (Order entered April 20, 1966, on Radiant's Motion for Leave to File Second Petition for Rehearing). Thus this Court has reserved to itself sole jurisdiction to reconsider its earlier decision—if it chooses to do so.

Switzer's second point is that deviations from the law of the case are few and occur in only the most exceptional cases (Sw. Br. 34-35). The parties are in full accord on this issue (R. Br. 41-45). This Court has well noted that "While the power to re-examine questions previously determined should be sparingly exercised, there are occasions when justice requires that course." [*United States v. Fullard-Leo* (9 Cir. 1946), 156 F.2d 756, 757]. Radiant urges that this is one of those occasions.

Radiant appeals entirely to this Court's discretion in presenting this issue and trusts that no longer will this Court deem Radiant to be a "disgruntled litigant" (299 F.2d at p. 169). Switzer's suggestion, by quotation from *Coleman Company v. Holly Manufacturing Company* (9 Cir. 1959), 269 F.2d 660, at 664, that Radiant "is still unregenerate and unconvinced" (Sw. Br. 36) should be considered, Radiant submits, in the light of what Switzer's experts

have admitted to be the true facts, in the light of the case law which has developed since the earlier decision and in the light of Switzer's present contentions on the contempt proceedings.

Switzer's third point is that Radian is in error in urging that the prior judgment is interlocutory (Sw. Br. 35-37). Radian submits the issue on the authorities set forth in its opening brief (R. Br. 45-47).

Switzer's fourth point is that Radian is in error in urging that this Court did not fully cover the statute on the first appeal (Sw. Br. 37-38). Radian's argument (R. Br. 47-49) was based upon the specific language of this Court in opening and closing its discussion of the issue, to-wit (299 F.2d 165, 166):

"Radian's second attack upon the validity of the patent is addressed to the fact that the limits of melamine are expressed in functional language. . . ."

* * * * *

"We conclude that the fact that the limits of melamine are, in the claims, stated in functional language does not render the patent invalid."

Radian does not understand that this Court did in fact intend to dispose of the balance of its earlier argument upon the inferential basis of the italicized language which Switzer quotes (Sw. Br. 38). If this Court did, however, intend so to do, then Switzer's point is, of course, well taken. But then the new facts and circumstances which Switzer has now injected in the case establish that Switzer led this Court into clear error in reaching those italicized conclusions and they justify a reconsideration upon the basis of the authorities set forth at pages 49-50, 58-62 and 75-79 of Radian's Opening Brief.

On this point, it should not be inferred that the defense was actually covered by the affirmation of the opinion of Judge Goodman. Judge Goodman, likewise, limited consideration of the statutory issue to the functional language as appears from his statement (OR 136), "It is urged that the claims are void because the maximum and minimum limits of the melamine compound are

expressed partially in functional terms. . . ." He did not cover the question of whether the claims particularly point out and distinctly claim the invention which he found to be present in the Kazenas patent.

Switzer's last point is that the recent decisions upon which Radiant relies "are strictly reaffirmations of case law that existed long prior to the decisions handed down by this Court in this litigation" (Sw. Br. 39, 38-41). This is precisely Radiant's point (R. Br. 75-79). Somehow or another Switzer must have left this Court with the earlier impression that such prior case law was technical and out of date and that it should have been discarded or distinguished.* Certainly, Switzer convinced Judge Goodman that at least a part of Radiant's attack on claimed defects in the patent itself "could only be sustained by a hypercritical and piecemeal analysis of the patent." (OR 134). The current authority illustrates that the statutory requirements of definiteness and certainty are embracive in scope, important to validity, and alive today. The reassertion by this Court in *Nelson v. Batson* (9 Cir. 1963), 322 F.2d 132 of the principles of *Brooks v. Fiske* (1853), 15 How. (56 U.S.), 212, 214-215 and *Evans v. Eaton* (1822), 7 Wheat. (20 U.S.), 356, 434 (noted Sw. Br. 39) and the application of those same principles, without citation of authority, in *Duff-Norton Company v. Ratcliff* (9 Cir. 1966), 362 F.2d 551 at page 553, soundly support Radiant's thesis.

On this same subject matter but in different context, the holding that there can be no utility in a patent claim if "the metes and bounds of that monopoly are not capable of precise delineation" as expressed in *Brenner v. Manson* (1966), 383 U.S. 519, at page 534, should be equally devastating to Switzer's prior successful attempt to avoid U. S. Code, Title 35, Section 112 because "the alternative would have been to state the critical lower limits precisely" (299 F.2d at p. 165). Implicit in *Brenner* is the view that claim language must be precise. Otherwise the patent "may

*For example, Switzer's written argument in its Brief for Defendant-Appellee in No. 16,780 states, p. 53, "No cases in support of Radiant's contentions, rendered since the adoption of the present Patent Statutes on January 1, 1953, have been called to this Court's attention."

engross a vast, unknown, and perhaps unknowable area." and "may confer power to block off whole areas of scientific development, without compensating benefit to the public." (383 U.S. 519 at p. 534).

In summation on this issue, Radiant submits that the flexible shifting position which Switzer has been able to take of the claims in suit in sustaining their validity on the first appeal and in sustaining contempt below is sound proof that Switzer is truly expert in "the highly developed art of drafting patent claims so that they disclose as little useful information as possible—while broadening the scope of the claim as widely as possible", an art to which the Court referred with displeasure in *Brenner v. Manson* (1966), 383 U.S. 519 at page 534.

Clearly, the rule of *United Carbon Co. v. Binney Co.* (1942), 317 U.S. 228, 237, that, "An invention must be capable of accurate definition, and must be accurately defined, to be patentable." is as sound today as it was when it was first written.

In conclusion on both issues, Radiant submits that the contempt judgment below should be reversed on the grounds submitted in support of Question 1 and that the initial judgment sustaining validity should be reversed on the grounds submitted in support of Question 2.

Respectfully submitted,

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Dated at San Francisco, California
September 9, 1966

CERTIFICATE OF COUNSEL

I certify that, in connection with the preparation of this brief, I have examined Rules 18 and 19 of the United States Court of Appeals for the Ninth Circuit, and that, in my opinion, the foregoing brief is in full compliance with those rules.

CARL HOPPE,

Attorney for Appellants.

(Appendix A Follows)

Appendix A

Excerpts taken from Appellants' Opening Brief in No. 16,780 which Radiant submits as showing it did not rely upon a quick qualitative test using toluene which required only 24 hours or at most one week to carry out.

FROM PAGES 56-58

The Japanese patent discloses the full substance of the alleged invention.

In the Statement of Facts we have shown that the face of the Japanese patent discloses a thermoplastic resin made by co-condensing formaldehyde, sulfonamide and melamine. The face of the patent also discloses that the specific recipe uses 5% melamine with respect to the amount of sulfonamide. The face of the patent does not disclose whether or not the Japanese resin has a sufficient amount of melamine to render the resin "substantially insoluble in aromatic-hydrocarbon solvents". However, the evidence adduced by Switzer makes clear that the Japanese resin is substantially insoluble in aromatic-hydrocarbon solvents (Spec. No. 7).

Dr. David B. Hatcher testified that the procedure of the Japanese patent was carried out under his direct supervision in his presence and that it was followed explicitly (R. 398-399). His resin had a softening point which was approximately 89° C. (R. 398) which differed from the 122° C. disclosed by the Japanese patent (R. 399). The result which he obtained is in evidence as Exhibit O (R. 398). Exhibit O was made by grinding the resin in a mortar and pestle, and putting 10 grams of the ground resin with 40 grams of toluene into a bottle and shaking the bottle to determine the solubility (R. 465). Dr. Hatcher testified that the resin was soluble in toluene (R. 399) and the District Court so found (R. 132). However, Dr. Hatcher's Exhibit O is before this Court for inspection. Inspection discloses that a substantial portion of the resin is agglomerated or coagu-

lated in the bottom of the jar and that this substantial portion is not in solution. Thus it is substantially insoluble.

Further, Dr. Hatcher in his affidavit filed in opposition to the Motion for Summary Judgment admitted that after a charge of 10 grams of the Japanese resin was admixed with 40 grams of toluene, that:

"* * * After standing for several days, it was found that approximately 20% of the powder was dissolved by the toluene." (R. 53).

When 80% of the resin is thus admitted to be insoluble after a period of several days and when a large portion of the resin is still not dissolved after the resin has been in contact with the toluene for a period of several years, one could ask for no more conclusive proof that the resin was "substantially insoluble" regardless of what the oral testimony might be.

Since there is a conflict between Dr. Hatcher's oral testimony and the physical exhibit, the finding is clearly erroneous under the rule of *Farmers' Cooperative Exchange v. Turnbow* (9th Cir. 1940), 111 F.2d 728, 731; *Galloway v. United States* (9th Cir. 1942), 130 F.2d 467, 471; and *United States v. Perry* (8th Cir. 1932), 55 F.2d 819, 822.

Dr. Hatcher tried to distinguish the Japanese resin from the Kazenas resin by demonstrating that his specimen of the Japanese resin (Exhibit O) had agglomerated in the toluene and by showing that his specimen of Kazenas' Example 5 (Exhibit N, R. 400) did not agglomerate and remained free-flowing after being dispersed in toluene. He testified that this resin was prepared in late August of 1958, that it had been in his presence since that time, and that the resin was still insoluble and free-flowing at the time of the trial (R. 401). Subsequent developments make clear that Dr. Hatcher and the District Court both erred in the conclusion to be drawn from this testimony. Inspection of Exhibit N shows that it is not free-flowing and that it does agglomerate in a jar upon leaving it alone for a period of time. Therefore, if a difference is to be found between the Japanese resin and the

Kazenas resin arising from any alleged ability to remain free-flowing in an aromatic-hydrocarbon solvent, the evidence presented by the defendant "is positively contradicted by the physical facts" (*Galloway v. United States* (9th Cir. 1942), 130 F.2d 467, 471) and is not entitled to any credence on this appeal.

FROM PAGES 94-95

* * * The word "sufficient" does not give the slightest clue as to whether the lower limit of the melamine component is 5%; 10%; 11%; 13% or any other percentage based on the weight of the sulfonamide. The words "substantially insoluble" are not stated to be quantitative or qualitative. If the words "substantially insoluble" are words of quantitative limitation, they do not give the slightest clue as to whether substantially means 51%; 75%; 80%; 90%; 99% or any other percentage. If the words "substantially insoluble" are words of qualitative limitation denoting that the resin can be suspended in aromatic hydrocarbon solvents without coalescence or agglomeration, the claims do not give the slightest clue as to the time, temperatures or other conditions under which the resin must have that capability. Radiant submits that on their face the words "sufficient" and "substantially insoluble" do not fulfill their statutory duty of "particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention."

